



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,353	01/31/2001	Neil R.N. Enns	13768.178.1	4025

22913 7590 06/29/2004

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &
SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2645

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,353

Applicant(s)

ENNS ET AL.

Examiner

Lisa Hashem

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1, 10, 20, 23, 24, and 25 recite the limitation "the acts". There is insufficient antecedent basis for this limitation in these claims.
3. Claims 5, 13, 14, 21, 22, and 29 recite the limitation "the data stream". There is insufficient antecedent basis for this limitation in these claims.
4. Claims 8, 15, 23, and 32 recite the limitations "the selection" and "the press".

There is insufficient antecedent basis for these limitations in these claims.
5. Claims 9, 15, 24, and 33 recite the limitation "the size". There is insufficient antecedent basis for this limitation in these claims.
6. Claims 19 and 22 recite the limitation "the act". There is insufficient antecedent basis for this limitation in these claims.
7. Claim 22 recites the limitation "the storage format". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2645

9. Claims 1-4, 6-9, 10-13, 15-20, 22-28, and 30-33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,745,024 by DeJaco et al, hereinafter DeJaco.

Regarding claim 1, DeJaco discloses in a computerized system that includes one or more mobile devices or (handheld wireless communications device) HHD (Figure 4, 100) and an electronic message server (integrated e-mail processor) IEP (Figure 4, 220) supporting wireless communication, wherein at least some of the mobile devices have an input system that is optimized for numeric input rather than text input, and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (column 5, lines 18-43), a method of composing an electronic message using a mobile device (see Abstract; column 5, line 66 – column 6, line 2; column 6, lines 7-10), the method comprising acts of: receiving a command to begin composing an electronic message at a mobile device (column 7, lines 7-35); receiving a command to add audio content to the electronic message at the mobile device (column 8, lines 15-27); inherently diverting to a temporary storage within the mobile device (column 11, lines 3-5), an audio content stream within the mobile device received at an audio input; storing the audio content stream in a format that is compatible with adding audio content to the electronic message (column 8, lines 25-31); and attaching the formatted audio content to the electronic message at the mobile device (column 8, lines 65-66; column 10, line 62 – column 11, line 21).

Regarding claim 2, a method as recited in claim 1, wherein DeJaco further discloses the mobile device comprises a phone (Figure 4, 100) and the temporary storage comprises a temporary data file, and wherein the audio content stream received at the

Art Unit: 2645

audio input is generated by a user speaking into the phone's mouthpiece (column 7, lines 21-25; column 7, line 62 – column 8, line 12; column 8, line 65 – column 9, line 5; column 9, lines 15-22).

Regarding claim 3, a method as recited in claim 1, wherein DeJaco further discloses the electronic message comprises an electronic mail message, and wherein the formatted audio content is attached as an electronic mail attachment (column 7, lines 29-35; column 8, lines 15-18 and lines 28-31).

Regarding claim 4, a method as recited in claim 3, wherein DeJaco further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message, the method further comprising the act of receiving the specific electronic mail message (column 7, lines 29-43).

Regarding claim 6, a method as recited in claim 1, wherein DeJaco further discloses the format used to store the audio content stream inherently allows for data compression, the method further comprising the act of compressing the audio content stream in accordance with the storage format (column 8, line 65 – column 9, line 5; column 9, lines 13-22).

Regarding claim 7, a method as recited in claim 6, wherein DeJaco further discloses the storage format is a WAV file format (column 9, lines 13-15).

Regarding claim 8, a method as recited in claim 1, wherein DeJaco further discloses receiving the command to add audio content to the electronic message is based on either a selection of a user interface menu item to add audio content to the electronic message or a press of a record button (column 8, lines 22-27; column 9, lines 42-51).

Art Unit: 2645

Regarding claim 9, a method as recited in claim 1, wherein DeJaco further discloses the acts of: inherently displaying an indicator that audio content has been attached to the electronic message (column 3, lines 16-48); and displaying a size of the attached audio content (column 9, lines 13-15).

Regarding claims 10, 11, and 13, please see the rejections of the method in claims 1, 4, and 6 mentioned above, respectively, to reject the method in claims 10, 11, and 13.

Regarding claim 15, please see the rejections of the method in claims 8 and 9 mentioned above, to reject the method in claim 15.

Regarding claim 12, a method as recited in claim 10, wherein DeJaco further discloses attaching the formatted audio content to the electronic mail message complies with a Multipurpose Internet Mail Extensions specification (column 3, lines 16-27).

Regarding claims 16 and 20, please see the rejection of the method in claim 1 mentioned above, to reject the method in claims 16 and 20.

Regarding claims 17-19, 22, and 24, please see the rejections of the method in claims 2-4, 6, and 9 mentioned above, to reject the method in claims 17-19, 22, and 24.

Regarding claim 23, please see the rejections of the method in claims 1 and 8 mentioned above, to reject the method in claim 23.

Regarding claims 25-28 and 30-33, please see the rejections of the method in claims 1-4 and 6-9 mentioned above, respectively, to reject the method in claims 25-28 and 30-33.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2645

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,745,024 by DeJaco as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. US 2002/0054750 by Ficco et al, hereinafter Ficco.

Regarding claim 5, a method as recited in claim 1, wherein DeJaco further discloses the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum (column 8, line 65 – column 9, line 5; column 11, lines 3-5), the method further comprising the act of displaying a progress indicator to show an ongoing audio input process (column 8, lines 22-27).

Dejaco fails to disclose the method further comprising the act of displaying a progress indicator to show a current amount of temporary storage used in storing a data stream compared to the predetermined maximum.

Ficco discloses a method for displaying the status of a recording device such as a set top box (STB) equipped with a digital video recorder (DVR) (see Figure 1; Abstract). A suitable user command interface may be used in order to transmit a command to display desired status parameter(s). Status parameters displayed include the time that a recording is behind a live feed, whether a program being viewed is live or recorded, available storage capacity for recording, visual/audiovisual alerts indicating various levels of storage available for recording, and other file attributes associated with the functionality and operation of the STB-equipped with DVR. A hard disc drive (HDD) (Figure 6, 320) is a mass storage device of the apparatus. Figures 12a and 12b display a progress indicator or Disk Gas Gauge status parameter that indicates the percent of the

Art Unit: 2645

HDD that has been consumed by recorded material, wherein the HDD has a predetermined maximum of 25 Gbytes (section 0069, lines 1-10; section 0106, lines 1-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of DeJaco to include a progress indicator as taught by Ficco to display the current amount of temporary storage in the memory of the mobile device compared the predetermined maximum. One of ordinary skill in the art would have been lead to make such a modification since the memory is limited to a predetermined maximum and the user will be able to see the current amount of storage used in storing the audio content stream.

12. Claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over U.S. Patent No. 6,745,024 by DeJaco as applied to claim 10 above, and further in view of U.S. Patent Application Publication No. US 2002/0054750 by Ficco.

Regarding claim 14, please see the rejection of the method in claim 5 mentioned above, to reject the method in claim 14.

13. Claim 21 rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over U.S. Patent No. 6,745,024 by DeJaco as applied to claim 16 above, and further in view of U.S. Patent Application Publication No. US 2002/0054750 by Ficco.

Regarding claim 21, please see the rejection of the method in claim 5 mentioned above, to reject the method in claim 21.

14. Claim 29 rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over U.S. Patent No. 6,745,024 by DeJaco as applied to claim 25 above, and further in view of U.S. Patent Application Publication No. US 2002/0054750 by Ficco.

Art Unit: 2645

Regarding claim 29, please see the rejection of the method in claim 5 mentioned above, to reject the method in claim 25.

Response to Arguments

15. Applicant's arguments with respect to claims 1-33 received on April 13, 2004 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2002/0059073 by Zondervan et al disclose a computer program product wherein a user can compose a message and attach a short audio recording to said message

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2645

19. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

20. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302.

The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general
nature or relating to the status of this application or proceeding should be directed to the
Group receptionist whose telephone number is (703) 305-3900.

LH
lh

June 18, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

